

REMARKS

Claims 1 through 22 have been canceled.

Claims 23 through 31 are pending.

Examiner has rejected claims 23 through 31 under 35 U.S.C. § 103(a) as being unpatentable over USPN 6,785,724 (Drainville) in view of USPN 6,317,831 (King). Applicant respectfully traverses the rejection and requests reconsideration.

Criteria for a Rejection under 35 U.S.C. § 103(a)

The U.S. Patent and Trademark Office has set forth a methodology for establishing a *prima facie* case of obviousness. Specifically three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

See MPEP 706.02 (j).

Appellant believes the Examiner has failed to establish a *prima facie* case of obviousness for the claims extant in the present case because there are claim limitations that are not taught or suggested by any of the cited references. Further, Examiner has failed to provide an adequate suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Drainville in light of King. Below, Applicant discusses limitations in the independent claims 23, 26 and 29 not

disclosed or suggested by the cited art. On the basis of this, Applicant believes all the claims are patentable over the cited art.

Independent Claim 23:

Independent claim 23 sets out a method by which a portable computer in a sleep mode responds to a wireless communication from a personal digital assistant. None of the cited art discloses or suggests a method by which a portable computer in a sleep mode responds to a wireless communication from a personal digital assistant.

Drainville:

Examiner has asserted that remote device 22 shown in Figure 1 of Drainville is a portable computer. However, nothing in Drainville discloses or suggests that this is so. In fact, Drainville teaches away from remote device 22 being a portable computer. Specifically, remote device 22 is an on-demand web server 22 wired to an idle phone line 38 through modem 16. See Drainville at column 5, lines 41 through 44. It is clear from this teaching of Drainville that Drainville is not disclosing or suggesting that remote device 22 is a portable computer, but rather is specifically disclosing that remote device 22 is an on-demand web server 22 wired to an idle phone line 38 through a modem.

Since Drainville does not disclose a portable computer and does not disclose a personal digital assistant, it is clear that Drainville does not

disclose or suggest a portable computer responding to a communication from a personal digital assistant.

In independent claim 23, the portable computer is awakened from the sleep mode in response to the wireless communication from the personal digital assistant. A response is generated and the response is transmitted via another wireless communication transmission.

This is not disclosed or suggested by Drainville. Particularly, Drainville teaches that remote device 22 is an on-demand web server 22 wired to an idle phone line 38 through modem 16. See Drainville at column 5, lines 41 through 44. Thus Drainville does not disclose or suggest transmission of responses from a portable computer via wireless communication transmission. Rather, Drainville teaches that on-demand web server 22 responds to requests via wired connections through a modem.

King:

Examiner has argued that King discloses wireless communications from a personal digital assistant. Applicant concedes that King shows it is possible for a personal digital assistant to perform wireless communication.

Modification of Drainville by King:

Examiner has additionally asserted that an advantage of the system taught by King is a quickly achieved secure connection (column 4, lines 61

through 66). Examiner has argued that it would have been obvious to one of ordinary skill in the art at the time of invention to modify Drainville by King. Motivation to combine is the ability to quickly create a secure connection.

The motivation offered by Examiner for modifying Drainville in light of King is insufficient and not really applicable to the situation of Drainville. Specifically, at column 4, lines 61 through 66, King indicates that one advantage of the invention of King is that a secure connection can be established over a one-way channel. However, Drainville is not concerned with establishing a one-way channel, but is concerned with providing access to a web server 22. Access to a web server requires two-way communication. Therefore, the ability to establish a secure one-way channel would not motivate one of ordinary skill in the art to modify Drainville because a secure one-way channel is not particularly useful when implementing a web server and would provide no motivation for a person of ordinary skill in the art to modify Drainville

Further, a prior patent must be considered in its entirety (i.e., as a whole), including portions that would lead away from the invention in issue. *Panduit Corp. v. Dennison Manufacturing Co.*, 810 F.2d 1561, 1 U.S.P.Q.2d 1593 (Fed Cir. 1987). It is impermissible within the framework of 35 U.S.C. § 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what

such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 U.S.P.Q. 416 (Fed Cir. 1986).

When Drainville is regarded as a whole, it is clear that the modification suggested by Examiner is not obvious. The Abstract of Drainville specifically states that Drainville discloses a system and method that allows one network device that is connected to the Internet to gain access to another network device via the Internet that is initially off-line and connected to an idle phone line, but is ultimately brought on-line, on-demand, in a seamless manner by the first network device for information access. This theme of a network server that is connected to an idle phone line and provides access to devices through a phone line is an essential feature of Drainville and, in fact, it is the very invention of Drainville. Modifying Drainville, as suggested by Examiner, to replace communication through a modem with one way communication to a personal digital assistant through a wireless network would destroy the invention of Drainville. However, the modification of a reference which results in destroying that on which the invention of the reference is based should not serve as a foundation for a rejection under 35 U.S.C. § 103. See, for example, *Ex parte Hartmann*, 186 U.S.P.Q. 366, 367 (PTO Bd. App. 1974).

Independent Claim 26:

Independent claim 26 sets out a method by which a portable computer in a sleep mode responds to a wireless communication from a personal digital assistant. None of the cited art discloses or suggests a method by which a

portable computer in a sleep mode responds to a wireless communication from a personal digital assistant.

Drainville:

Examiner has asserted that remote device 22 shown in Figure 1 of Drainville is a portable computer. However, nothing in Drainville discloses or suggests that this is so. In fact, Drainville teaches away from remote device 22 being a portable computer. Specifically, remote device 22 is an on-demand web server 22 wired to an idle phone line 38 through modem 16. See Drainville at column 5, lines 41 through 44. It is clear from this teaching of Drainville that Drainville is not disclosing or suggesting that remote device 22 is a portable computer, but rather is specifically disclosing that remote device 22 is an on-demand web server 22 wired to an idle phone line 38 through a modem.

Since Drainville does not disclose a portable computer and does not disclose a personal digital assistant, it is clear that Drainville does not disclose or suggest a portable computer responding to a communication from a personal digital assistant.

In independent claim 26, the portable computer is awakened from the sleep mode in response to the wireless communication from the personal digital assistant. Drainville does not disclose or suggest a portable computer being awakened from the sleep mode in response to the wireless communication from a personal digital assistant.

In independent claim 26, an action is performed in response to the wireless communication by the personal digital assistant. Drainville does not disclose or suggest an action being performed in response to a wireless communication by a personal digital assistant.

King:

Examiner has argued that King discloses wireless communications from a personal digital assistant. Applicant concedes that King shows it is possible for a personal digital assistant to perform wireless communication.

Modification of Drainville by King:

Examiner has additionally asserted that an advantage of the system taught by King is a quickly achieved secure connection (column 4, lines 61 through 66). Examiner has argued that it would have been obvious to one of ordinary skill in the art at the time of invention to modify Drainville by King. Motivation to combine is the ability to quickly create a secure connection.

The motivation offered by Examiner for modifying Drainville in light of King is insufficient and not really applicable to the situation of Drainville. Specifically, at column 4, lines 61 through 66, King indicates that one advantage of the invention of King is that a secure connection can be established over a one-way channel. However, Drainville is not concerned with establishing a one-way channel, but is concerned with providing access to a

web server 22. Access to a web server requires two-way communication.

Therefore, the ability to establish a secure one-way channel would not motivate one of ordinary skill in the art to modify Drainville because a secure one-way channel is not particularly useful when implementing a web server and would provide no motivation for a person of ordinary skill in the art to modify Drainville

Further, a prior patent must be considered in its entirety (i.e., as a whole), including portions that would lead away from the invention in issue. It is impermissible within the framework of 35 U.S.C. § 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. When Drainville is regarded as a whole, it is clear that the modification suggested by Examiner is not obvious. The Abstract of Drainville specifically states that Drainville discloses a system and method that allows one network device that is connected to the Internet to gain access to another network device via the Internet that is initially off-line and connected to an idle phone line, but is ultimately brought on-line, on-demand, in a seamless manner by the first network device for information access. This theme of a network server that is connected to an idle phone line and provides access to devices through a phone line is an essential feature of Drainville and, in fact, it is the very invention of Drainville. Modifying Drainville, as suggested by Examiner, to replace communication through a modem with one way communication to a personal digital assistant through a wireless network would

destroy the invention of Drainville. However, the modification of a reference which results in destroying that on which the invention of the reference is based should not serve as a foundation for a rejection under 35 U.S.C. § 103.

Independent Claim 29:

Independent claim 29 sets out storage media storing software which when executing on a portable computer performs a method by which the portable computer responds to a wireless communication from a personal digital assistant. None of the cited art discloses or suggests a method by which a portable computer in a sleep mode responds to a wireless communication from a personal digital assistant.

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Since Drainville does not disclose a portable computer and does not disclose a personal digital assistant, it is clear that Drainville does not disclose or suggest a portable computer responding to a communication from a personal digital assistant.

In independent claim 29, the portable computer is awakened from the sleep mode in response to the wireless communication from the personal digital assistant. Drainville does not disclose or suggest a portable computer being awakened from the sleep mode in response to the wireless communication from a personal digital assistant.

In independent claim 29, an action is performed in response to the wireless communication by the personal digital assistant. Drainville does not disclose or suggest an action being performed in response to a wireless communication by a personal digital assistant.

King:

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Conclusion

Applicant believes that this Amendment has placed the present case in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,

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